

## **REMARKS**

Claims 1 through 3, 6 through 11 and 13 through 20 are pending in the case.

Examiner has rejected claims 1 through 3, 6 through 11 and 13 through 20 under 35 U.S.C. § 103 (a) as being unpatentable over USPN 6,201,384 B1 (Alexander) in view of USPN 5,381,524 (Lewis). Applicant has amended the independent claims. Applicant respectfully traverses the rejection of the claims, as amended, and requests reconsideration.

Below, Applicant presents reasons why each of the independent claims is not disclosed or suggested by the cited art. On the basis of this, Applicant believes the independent claims discussed below and all the claims dependent thereon are patentable over Lewis.

### **Discussion of Independent Claim 1**

#### **Discussion of display:**

Claim 1 sets out an electronic instrument that includes a display. The display displays a menu that shows a plurality of parameters for the displayed signal waveform. This is not disclosed or suggested by Alexander or Lewis. Examiner has conceded that Alexander does not explicitly teach such a menu.

Discussion of Lewis:

Examiner has argued that it would be obvious to place menu components as per Lewis into Alexander. Examiner refers specifically to menus 60, shown in Figure 3 of Lewis and column 3, lines 55 through 57 of Lewis.

Pull-down menus 60, shown in Figure 3 of Lewis, appear to be standard pull down menus available on programs operating under the Windows operating system available from Microsoft Corporation. There are listed 6 standard pull down menus: File, Edit, View, Options, text and Window. See Lewis at Figure 3 and column 8, line 66 through column 9, line 1.

At column 3, lines 55 through 57, Lewis refers to basic concepts within the Windows operating environment such as selecting objects, editing text, working with menus and dialog boxes.

Essentially then, Examiner appears to be citing Lewis as an example of the specific pull-down menus available within the Windows operating environment.

However, none of the menus disclosed by Lewis perform the specific functionality set out by claim 1. Specifically, none of the menus in Lewis disclose or suggest a menu that shows a plurality of parameters for a displayed signal waveform.

### Combination of Alexander and Lewis

If a person of ordinary skill in the art were to add the pull-down menus taught by Lewis into the subject matter taught by Alexander, the end result would be the addition of the standard pull down menus (File, Edit, View, Options, text and Window) from the Windows operating environment into the subject matter taught by Alexander. This would not disclose or suggest the present invention.

Specifically, neither Alexander nor Lewis disclose or suggest the specific menu functionality set out in claim 1 of the present case. That is, neither Alexander nor Lewis disclose or suggest a menu that shows a plurality of parameters for a displayed signal waveform. Such a menu, or the desirability of such a menu, is taught only by Applicant's Specification. Nothing in Alexander nor Lewis provide any suggestion or motivation to add such a menu into the subject matter disclosed by Alexander.

As Examiner has conceded, Alexander does not explicitly teach such a menu. Lewis only indicates the existence of menus, but does not provide any disclosure or suggestion of a menu with the particular functionality as that set out by claim 1 of the present case. Further, neither Alexander nor Lewis provide any motivation for developing such a menu and adding such a menu to the subject matter disclosed by Alexander.

### Motivation to Combine Alexander and Lewis

Examiner has argued the following with respect to motivation.

It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to employ "parameter"-selecting "menu" components as per Lewis in the Alexander "electronic instrument" environment, so that a wider variety of "parameter" selections might be made available. Motivation rests at least in Alexander's "pointing device"-centric implementation, where the pointer would have more use with a menu to select further features.

In the first place, Examiner has failed to recognize the clear differences between what Lewis discloses and the subject matter set out by claim 1 of the present case. Examiner has only shown that Lewis includes specific pull-down menus available within the Windows operating environment. Examiner has called these standard menus "parameter"-selecting "menu" components. However, none of the pull-down menus available within the Windows operating environment disclosed by Lewis show a plurality of parameters for a displayed signal waveform, as set out in claim 1 of the present case. Thus Lewis does not disclose or suggest a menu that shows a plurality of parameters for the displayed signal waveform as set out in claim 1 of the present case.

Examiner has argued that motivation for combining the menus disclosed by Lewis into Alexander "rests at least in Alexander's "pointing device"-centric implementation, where the pointer would have more use with a menu to select further features."

However, nothing in Alexander or Lewis teaches that a pointer would have more use with a menu to select further features. The advantage of a menu that shows a plurality of parameters for a displayed signal waveform is only taught by Applicant's Specification. Such a teaching is not found in Alexander or Lewis.

Examiner has further argued: "the adjustment *"per se* of a parameter that is seen through the use of user-created rectangular regions 310 in Alexander would become desirably expanded to a larger number of 'pointing device'-mediated 'parameter'-setting operations, given a "menu" as per Lewis." However, nothing in Alexander or Lewis teaches this. Only the Specification of the present case shows the advantage of using a menu that shows a plurality of parameters for the displayed signal waveform. Examiner has merely used information gleaned from the Specification of the present case to provide the motivation to make changes to Alexander. This is impermissible.

The courts have clearly held that for a rejection under 35 U.S.C. § 103, the prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. See *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438 (PTO Bd. App. 1984). The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. See *In re Newell*, 891 F.2d 899, 12

U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989). Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. *In re Dow Chemical Col.*, 837 F.2d 469, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988).

**Discussion of logic:**

Claim 1 sets out that logic within the electronic instrument allows selection of a parameter from the plurality of parameters and adjusts values for the parameter selected from the plurality of parameters based on locations on the display selected by a user using the pointing device. This is not disclosed or suggested by Alexander or Lewis. Neither Alexander or Lewis disclose or suggest allowing selection of a parameter from a plurality of parameters and then adjusting values for the parameter selected from the plurality of parameters based on locations on the display selected by a user using a pointing device.

Applicant notes that this differs significantly from the menus taught by Lewis. Lewis discloses that pull-down menus are available within the Windows operating environment. None of these menus within Lewis disclose or suggest selection of a parameter from a plurality of parameters and then adjustment of values for the parameter selected from the plurality of parameters based on locations on the display selected by a user using a pointing device.

### **Discussion of Independent Claim 9**

#### **Displaying a menu:**

Claim 9 sets out a method that includes displaying a menu that shows a plurality of parameters for the displayed signal waveform. This is not disclosed or suggested by Alexander or Lewis. Examiner has conceded that Alexander does not explicitly teach such a menu.

Examiner has argued that it would be obvious to place menu components as per Lewis into Alexander. Examiner has argued that motivation for this “rests at least in Alexander’s “pointing device”-centric implementation, where the pointer would have more use with a menu to select further features.” However, neither Alexander nor Lewis teach that the pointer in Alexander would have more use with a menu to select further features. This teaching is available only from Applicant’s Specification. Examiner, therefore, has failed to find proper motivation for the suggested combination of Alexander and Lewis.

#### **Adjusting values:**

Claim 9 sets out that in response to a user selecting a parameter from the plurality of parameters and using a pointing device to select a location on the display, values for the parameter selected from the plurality of

parameters are adjusted based on locations on the display selected by the user using the pointing device. Neither Alexander or Lewis disclose or suggest that in response to a user selecting a parameter from a plurality of parameters and using a pointing device to select a location on a display, values for the parameter selected from the plurality of parameters are adjusted based on locations on the display selected by the a using a pointing device.

Lewis discloses that pull-down menus are available within the Windows operating environment. None of these menus within Lewis disclose or suggest selection of a parameter from a plurality of parameters and then adjustment of values for the parameter selected from the plurality of parameters based on locations on the display selected by a user using a pointing device.

### **Discussion of Independent Claim 16**

#### **Displaying a menu:**

Claim 16 sets out storage media for storing software which when run on a device that has computing capability performs a method. The method includes displaying a menu that shows a plurality of parameters for the displayed signal waveform. This is not disclosed or suggested by Alexander



or Lewis. Examiner has conceded that Alexander does not explicitly teach such a menu.

Examiner has argued that it would be obvious to place menu components as per Lewis into Alexander. Examiner has argued that motivation for this “rests at least in Alexander’s “pointing device”-centric implementation, where the pointer would have more use with a menu to select further features.” However, neither Alexander nor Lewis teach that the pointer in Alexander would have more use with a menu to select further features. This teaching is available only from Applicant’s Specification. Examiner, therefore, has failed to find proper motivation for the suggested combination of Alexander and Lewis.

**Adjusting values:**

Claim 16 sets out that in response to a user selecting a parameter from the plurality of parameters and using a pointing device to select a location on the display, values for the parameter selected from the plurality of parameters are adjusted based on locations on the display selected by the user using the pointing device. Neither Alexander or Lewis disclose or suggest that in response to a user selecting a parameter from a plurality of parameters and using a pointing device to select a location on a display, values for the parameter selected from the plurality of parameters are


adjusted based on locations on the display selected by the a using a pointing device.

Lewis discloses that pull-down menus are available within the Windows operating environment. None of these menus within Lewis disclose or suggest selection of a parameter from a plurality of parameters and then adjustment of values for the parameter selected from the plurality of parameters based on locations on the display selected by a user using a pointing device.

### Conclusion

Applicant believes this Amendment has placed the present Application in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,  
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